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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/524,486	11/17/2005	Stefan Laufer	264821US0PCT	6298
22850 7590 02/09/2009 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER MORRIS, PATRICIA L	
			ART UNIT	PAPER NUMBER
			1625	
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			02/09/2009	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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patentdoCKET@oblon.com  
oblonpat@oblon.com  
jgardner@oblon.com



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Harris A. Pitlick  
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C.  
1940 DUKE STREET  
ALEXANDRIA VA 22314

In re Application of	:
Laufer et al	:Decision on Petition
Serial No.: 10/524,486	:
Filed : 17 November 2005	:
Attorney Docket No.: 264821PCT	:

This letter is in response to the Petition under 37 C.F.R. 1.181 filed on 7 November 2008 requesting reconsideration of the lack of unity requirement mailed 27 October 2007.

## BACKGROUND

This application was filed as a national stage of a PCT application and as such is entitled to PCT unity of invention rules.

On 5 March 2007, the examiner set forth a lack of unity requirement which divided the claims into products and processes and required an election of species, for example, among the compounds of Example 1 or Example 28, etc. The examiner reasoned that the compounds contain a pyridine which does not define a contribution over the prior art. No prior art was cited.

On 3 April 2007, applicants elected Group I, and species of Example 54 with traverse.

On 30 May 2007, the examiner considered the traversal and maintained the lack of unity determination.

Following several rounds of prosecution, on 12 September 2008, the examiner issued a non-final Office action in which claims 16-38 were pending. On the form PTOL-326, the examiner accounted for the claims as follows:

Claims 16-38 are pending.  
Claim 16, 24, 27, 34 and 36 are rejected.  
Claims 17-23, 25-33, 35 and 38 are objected to.

In the body of the Office action, the examiner accounted for the claims as follows:

Claims 24, 34, 36 and 37 are rejected under 35 U.S.C. 112 1<sup>st</sup> paragraph for lack of enablement.

Claim 16 is rejected under 35 U.S.C 112 2<sup>nd</sup> paragraph for indefiniteness.

Claim 17-23 were objected to for being dependent upon a rejected base claim, but would be allowable if re-written in independent form including all limitations of the base claim and any intervening claims.

Claim 25 is objected to as containing non-elected subject matter.

Claims 26-33, 35 and 38 if presented in independent form or made dependent upon an allowable claim would appear to be allowable.

The examiner states that "this application has been examined to the extent readable on the elected compound wherein R10 represents a tetrahydropyran and nonheterocyclic groups, B represents nonheterocyclic groups and R1-R7 A and m as set forth in claim 1, exclusively. Claim 25 and those dependent thereon all embrace additional heterocycles. Claims 24 and 34 has (sic, have) been examined to the extent readable on the treatment of rheumatoid arthritis since applicant (sic, text missing)."

On 7 November 2008, applicants filed this petition.

On 12 January 2009, applicants filed a response to the Office action.

## **DISCUSSION**

The file history and petition have been considered carefully.

Before turning to the merits of the petition, it is noted that the status of the claims in Office action mailed 12 September 2008 is inconsistent and incomplete in the PTOL 326 form and body of the Office action. Claims 27 is listed as rejected on the PTOL-326, while the body of the Office action does not include any rejection for Claim 27. Pending Claim 37 is left out of the accounting in the PTOL-326.

The petition requests examination of a second or subsequent species of Claim 25. Claim 25 is written in Markush format. MPEP 803.02 provides the following guidance on the examination of Markush claims:

If on examination the elected species is found to be anticipated or rendered obvious by prior art, the Markush-type claim and claims to the elected species shall be rejected, and claims to the nonelected species would be held withdrawn from further consideration. A second action on the rejected claims can be made final unless the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the

claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p). See MPEP § 706.07(a).

On the other hand, should the examiner determine that the elected species is allowable, the examination of the Markush-type claim will be extended. If prior art is then found that anticipates or renders obvious the Markush-type claim with respect to a nonelected species, the Markush-type claim shall be rejected and claims to the nonelected species held withdrawn from further consideration. The prior art search, however, will not be extended unnecessarily to cover all nonelected species. Should applicant, in response to this rejection of the Markush-type claim, overcome the rejection, as by amending the Markush-type claim to exclude the species anticipated or rendered obvious by the prior art, the amended Markush-type claim will be reexamined. The examination will be extended to the extent necessary to determine patentability of the Markush-type claim.

At present, there is no rejection pending on claim 25, nor is claim 25 indicated as allowable. For this reason, the Office action mailed 12 September 2008 is incomplete and will be vacated.

## DECISION

The petition filed under 37 CFR 1.144 on 23 January 2009 is **GRANTED**.

The restriction requirement between the product of Group I and process of Group II has been withdrawn in view of the fact that since the Office action dated 30 May 2007, the examiner has examined the process of Group II along with the elected product.

The Office action mailed 12 September 2008 is vacated as incomplete because it did not correctly or consistently account for the status of claims and because it was incomplete for not rejecting Claim 25 or indicate allowability of Claim 25.

The application will be forwarded to the examiner to consider the papers filed 12 January 2009 and to prepare a new non-final Office action on the pending claims consistent with this petition decision and with the guidance of MPEP 803.02.

Should there be any questions regarding this decision, please contact Special Program Examiner Julie Burke, by mail addressed to Director, Technology Center 1600, PO BOX 1450, ALEXANDRIA, VA 22313-1450, or by telephone at (571) 272-1600 or by Official Fax at 703-272-8300.



Remy Yucel  
Director, Technology Center 1600